

Application Serial No. 10/766,550
Amendment dated August 20, 2007
Reply to Office Action mailed March 20, 2007

REMARKS/ARGUMENTS

Claims 1-2, 4, 6-7, and 9-10 were rejected under 35 U.S.C. § 112, second paragraph. It was maintained that the steps of transporting the roll to the job site was inconsistent with rolling the membrane. Applicant requests reconsideration. The purpose of the present invention is to enable one to deliver to the job site roofing membrane that has a preapplied seam tape. Rolls of the membrane sheeting must be delivered to the job site. If the rolls have an uneven diameter, they cannot be easily positioned on a truck to be transported. Further, even unrolling the membrane at the job site would be much more difficult with a structure that has an uneven cross section. It is difficult to unroll the sheeting in a straight line. Having one large diameter end and one small diameter end simply presents problems for a roofer. Thus, by using applicant's method of folding the membrane upon itself to provide an even cross section throughout the roll, one solves these problems.

Thus, the steps of transporting and unrolling are all part of the present invention. One skilled in the art would clearly understand exactly what applicant is claiming. There is nothing indefinite about these steps. In light of this, applicant would request the withdrawal of the rejection under 35, U.S.C. § 112.

Claims 1-2, 6 and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over Leeuwenburgh in view of Chiu. The Leeuwenburgh reference discloses a method of rolling a masking product. It is a thin plastic sheet that has masking tape on the edges. This is a product that obviously is totally unsuited for roofing applications. It is a much smaller product. Although thickness of a roll may be a

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concern, it is not a critical issue as with rolling membrane roofing with preapplied seam tape. Whereas the product in the Leeuwenburgh reference can be shipped in a box, and an individual can carry, literally, dozens of the rolls at one time. One roll of applicant's material must be handled with a fork lift. In terms of the weights and sizes, there are differences in orders of magnitude. That is why applicant has structured the claim to indicate that the product is taken to the job site and applied. This clearly differentiates itself from the disclosure in Leeuwenburgh.

The Chiu reference simply discloses a seam tape applied to a roof membrane. Applicant maintains that is it unobvious to combine the teachings of these two references; that doing so is merely hindsight reconstruction. There is no reason why one of ordinary skill in the art would look to Leeuwenburgh to provide a roofing membrane. The teaching in the Leeuwenburgh reference would never be combined the Chiu reference by one skilled in the art.

The Court of Appeals for the Federal Circuit repeatedly preaches about improper hindsight reconstruction. The Supreme Court, likewise, has indicated that hindsight reconstruction is inappropriate. In *KSR International v. Teleflex, Inc.*, the Supreme Court stated:

"Often it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community are present or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there is an apparent reason to combine the known elements in the fashion claimed in the patent at issue. To facilitate review, this analysis should be made explicit."

The Court further stated:

"A patent composed of several elements is not proved obvious merely by demonstrating that each of the elements was independently known in the prior art. A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." (See Slip Opinion at page 17.)

Merely indicating that it would be obvious to combine the teaching of Chiu along with Leeuwenburgh to arrive at the present invention is clearly an inadequate basis for rejecting the claims. The rejection must be explicit as to the level of skill in the art and some reason for making the combination. Merely finding the elements of the present invention and various pieces of prior art is inadequate for establishing a prior art rejection.

One skilled in the art, when trying to deal with a 700 to 1000-pound roll of EPDM, is not going to be motivated to do anything by looking at a 14-ounce roll of thin plastic sheeting. In support of this, Applicant is submitting the Declaration of one of the inventors, David Robison. As he indicates, the sheets are typically 20 feet wide by 100 feet in length, or 25 feet wide by 100 feet in length. They can weigh from 754 to 943 pounds. These products cannot simply be rolled up when formed with preapplied seam tape. They could not possibly even market these rolls with preapplied seam tape without compensating for the increased thickness. This supports the conclusion that one skilled in the art would not look at a 14-ounce roll of thin plastic sheeting, and how it is rolled up, when trying to determine whether it is even feasible to manufacture a roofing membrane with a preapplied seam tape. For this reason, it is applicant's

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position that the rejection set forth in the previous Office Action is improper, and requests that the pending claims be allowed.

Claim 4 was rejected merely on the basis that EPDM and Neoprene are known plastic materials. Again, this is hindsight reasoning. The mere fact that something is available in the art does not in and of itself establish a prior art rejection. There must be some reason to make the change. This also applies to the rejections of claims 4 and 5.

Finally, claims 1 and 4-7 are rejected under 35 U.S.C. § 103(a) under Tuoriniemi in view of Kreckel and Chiu.

The Touriniemi patent, again, discloses a masking material. This combination is basically the same combination as the Leeuwenburgh/Chiu combination. Applicant maintains, again, that this is hindsight reconstruction of the claims, which is impermissible under KSR, and should be withdrawn. Merely finding the individual elements in the prior art is not sufficient to establish a *prima facie* case of obviousness. The Kreckel reference adds nothing to this rejection, it merely discloses a process for bundling articles together. It does not disclose any folding whatsoever.

With respect to the rejection of claims 1 and 10 over Leeuwenburgh in view of Enns and Chiu, the Enns patent simply discloses a pool liner. Pond liners are well known, and this reference, again, does not eliminate the deficiencies of the rejection based on Chiu in combination with Leeuwenburgh, as previously discussed.

In view of this, applicant requests reconsideration of the pending rejection, and allowance of the claims.

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Respectfully submitted,

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